

REMARKS

This Amendment, filed in reply to the Office Action dated November 29, 2006, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 7, 8, 10, 11, and 18-22 are all the claims pending in the application.

Claims 8, 11, 18-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Shiraishi et al. (U.S. Patent No. 4,617,468).

Claims 7-8, 10-11, 18-22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Tsuchiya et al. (U.S. Patent No. 5,672,514).

Applicant amends claim 8 to include the features of pending claim 18. Applicant further cancels claim 20. Applicant submits that the amendment to claim 8 should be entered because it merely rewrites previously pending subject matter into an independent claim. As amended, Applicant submits that the claims are patentable based on the following arguments.

Amended claim 8 describes means for attaching management information peculiar to the test piece to a predetermined location on the test piece, wherein the management information identifies the type and position of each probe, and wherein the management information is attached using the same marker used for marking the target substrate. Accordingly, claim 8 describes means performing the function of attaching management information, such as the type and position of each probe, using the same marker used for marking the target substrate. The nature of the management information is part of the recited function of a means plus function element.

In order for a prior art rejection to be maintained, the prior art must perform the identical function as a threshold matter. MPEP 2182. Determining a claimed function and identifying structure corresponding to that function involve distinct, albeit related, steps that must occur in a particular order. In short, function must be determined before corresponding structure can be identified. See, e.g., *Omega*, 334 F.3d at 1321 (“Once the functions performed by the claimed means are identified, we must then ascertain the corresponding structures in the written description that perform those functions.”); *BBA Nonwovens Simpsonville, Inc. v. Superior Nonwovens, L.L.C.*, 303 F.3d 1332, 1343 [64 USPQ2d 1257] (Fed. Cir. 2002) (stating that construction of a means-plus-function limitation “requires the court to first identify the function of the means-plus-function limitation and next identify the corresponding structure in the written description necessary to perform that function”); *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1113 [63 USPQ2d 1725] (Fed. Cir. 2002) (“After identifying the claimed function, the court must then determine what structure, if any, disclosed in the specification corresponds to the claimed function.”). *JVW Enterprises Inc. v. Interact Accessories Inc.*, 76 USPQ2d 1641, 1646 (Fed. Cir. 2005).

No aspect of the cited art (Shiraishi, Tsuchiya) teaches the attachment of management information identifying the type and position of each probe, using the same marker used for marking the target substrate. The Examiner’s contention that a spotter, an ink jet, gel electrophoresis and a pipette correspond to the claimed means for attaching management information falls short of teaching the identical function as recited. The Examiner’s cited elements merely apply the samples themselves to a substrate. None of the elements apply management information identifying the type and position of each probe using the same marker

as that used for the target substance. The Examiner asserts that a spotter, along with the other types of devices, may be capable of performing the function. However, this is not the correct test for determining patentability. The use of the spotter does not inherently attach management information identifying the type and position of each probe as claimed. In this regard, the Examiner is merely speculating that the identical function is being performed, and such speculation does not support a rejection. *In re Robertson*, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999). Moreover, there is no suggestion to teach the recited function in any of the cited art.

Because the Examiner's rejection does not even meet the first requirement of teaching of the identical function, it is premature to consider the structures to perform the function. Applicant, nonetheless points out that an embodiment of the invention includes attachment of management information via a bar code. See page 18. Referring to Fig. 9, for example, a main control portion 51 includes a program for encoding management information, such as the type and position of probes. See page 26. The management information is attached to the test piece using the same marker, such as by way of a printing device 53, that is used to apply the target substance. This can be done by providing the information in a certain pattern representing the management information. See pages 28-29.

To the extent that the prior art may teach some form of applicator of materials to a substrate, the application of management information identifying the type and position of probes is not an inherent and necessary result. Therefore, claim 8 is patentable for at least these reasons.

In similar regard, claims 11 and 21 describe attachment of management information, which is encoded to a test piece. As described by claims 11 and 21, the management information provides an identification function. The means by which the identification information is

attached using the same marker as that used for a target substance is described by example in the discussion of claim 8. To the extent Shiraishi and Tsuchiya may teach the general application of a marker using a spotter or printer, neither reference teaches attaching encoded management information for identification purposes as described by claims 11 and 21.

Applicant submits that the Examiner has placed undue emphasis on generic structures without giving proper consideration to the claimed function. Even in the Decision by the Board of Appeals, the Board gave careful consideration to the function(s) at issue. See the first full paragraphs on pages 8 and 9 of the Board Decision. The Examiner's over-reliance on the structure has led to an incorrect application of claim construction principles for means-plus-function elements.

Therefore, Applicant submits that independent claims 8, 11 and 21 are patentable and the remaining claims are patentable based on their dependency.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116
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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


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